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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,273	08/07/2002	Michel Perricaudet	ST99019 US PCT	8299

5487 7590 03/22/2006
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EXAMINER

BOESEN, AGNIESZKA

ART UNIT PAPER NUMBER

1648

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/018,273		PERRICAUDET ET AL.	
	Examiner		Art Unit	
	Agnieszka Boesen		1648	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-11,13-15 and 17-32 is/are pending in the application.
- 4a) Of the above claim(s) 6,12,16 and 33-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-5,7-11,13-15 and 17-32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1648

DETAILED ACTION

1. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Examiner Agnieszka Boesen of Group Art Unit 1648.

2. Applicant's amendment filed 10/02/2003 is acknowledged. Claims 1-5, 7-11, 13-15, and 17-32 are pending. Upon further consideration of the claimed invention, the pending claims are subject to a restriction requirement, specifically, an election of species. The Office acknowledges that this application is being restricted mid-prosecution. Any inconvenience is regretted.

Election/Restrictions

3. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack of unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1. Applicant is required to elect one species from each set of species listed below. The sets of species are as follows: I) Claims 4 and 5; II) Claim 10, III) Claim 13; IV) Claim 19; V) Claims 11,22, 24, 26, 28, and 31.

The species are as follows:

I. Pick one species of transporter from claims 4-5

- A) Murine iodine transporter (Na⁺/T Symporter) NIS, or
- B) Human iodine transporter (Na⁺/T Symporter) NIS

II. Pick one species of promoter from claim 9

- C) The promoter derived from regulatory sequence of the elastase I,
- D) regulatory sequence of insulin gene,
- E) regulatory sequence of the gene of immunoglobulins,
- F) regulatory gene of mouse mammary tumor virus,
- G) regulatory sequence of PSA gene,
- H) regulatory sequence of alpha 1-antitripsin gene,
- I) regulatory sequence of the β -globin gene,
- J) regulatory sequence of gene for basic myelin,
- K) regulatory sequence of the gene for the myosin light chain 2, or
- L) regulatory sequence of the gene for the gonadotrophin-releasing hormone

III. Pick one species of Adenovirus from claim 11

- M) Adenovirus is a human type Ad 2 or Ad 5, or
- N) Adenovirus is a canine type CAV-2

IV. Pick one species of viral promoter from claim 16

- O) Viral promoter is E1A
- P) Viral promoter is MLP
- Q) Viral promoter is CMV

R) Viral promoter is RSV-LTR

S) Viral promoter is MT-1, or

T) Viral promoter is SV-40

V. Pick one species of deletion from claims

T) Deletion of all or part an E1 region, or

V) Deletion of all or part of E4 region

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. The following claim(s) are generic: 1-3, 7-9, 14-18, 20, 21, 23, 25, 27, 29, 30, and 32.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: The structure of the murine symporter and the human symporter is not the same because they are derived from different organisms. The structures of the different promoters are not the same since they are derived from different organisms. The adenoviruses are not the same because they are derived from different organisms. The deletions are not the same because they occur at different locations along the E region. The special technical features of each of the species are listed above as A-V. Each has its own structure and is derived from a different organism.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Agnieszka Boesen, Ph.D. whose telephone number is 571-272-8035. The examiner can normally be reached on M – F (9:00AM - 5:30PM).


Art Unit: 1648

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 571-272-0902. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AB

Agnieszka Boesen, Ph.D.
March 14, 2006


JAMES HOUSEL 3/19/06
SUPERVISORY PATENT EXAMINER
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